

REMARKS

This is a full and timely response to the non-final Official Action mailed **February 19, 2009** (the “Office Action” or “Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Claims 8, 9, 32, 33, 44, 45, 52-69, 71, 78 and 79 were previously cancelled without prejudice or disclaimer.

By the forgoing amendment, claims 1-7 and 10-17 have been amended. Thus, claims 1-7, 10-31, 34-43, 46-51, 70, 72-77 and 80-84 are currently pending for further action.

Rejections under 35 U.S.C. § 101:

In the recent Office Action, claims 1-7 and 10-17 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. These claims have been carefully reviewed in light of the Examiner's comments.

While Applicant does not necessarily agree that any of these claims are directed to non-statutory subject matter, the indicated claims have been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 101. Specifically, claims 1 and 14 have been amended to recite a display device connected to at least one recording device and at least one source of audiovisual programming, the display device comprising a user interface.

Clearly, a display device specifically configured as recited in claims 1 and 14 is a machine and within the statutory categories of § 101. Support for the amendment to claims 1 and 14 can be found in Applicant’s originally filed specification at, for example, paragraph

[0015]. Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 101, and notice to that effect is respectfully requested.

Prior Art:

Rejections under 35 U.S.C. §103(a):

1. In the recent Office Action, claims 1-7, 10-13, 36-43, 46-51, 70, 72-77, and 80-84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0040475 to Yap et al. (hereinafter “Yap”) in view of U.S. Patent No. 7,441,124 to Hirasawa et al. (hereinafter “Hirasawa”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

With regard to the Hirasawa reference, Applicant respectfully submits that Hirasawa cannot be considered valid prior art. The present application claims priority under 35 U.S.C. § 119(e) from U.S. Provisional Patent Application No. 60/493,995, filed **August 8, 2003**.

However, Hirasawa is a U.S. Patent, issued on **October 21, 2008**. The Hirasawa reference was published in the United States under U.S. Patent Application Publication No. 2004/0068605 on **April 8, 2004**. Hirasawa claims priority to PCT/JP02/06799 filed **August 18, 2003**. Applicant’s provisional filing on **August 8, 2003** predates all these events.

In light of the above, Hirasawa cannot be applied as prior art under 35 U.S.C. § 102(a) because Hirasawa was not patented or described in this country before the filing of the present application. Further, Hirasawa does not qualify as prior art under 35 U.S.C. § 102(b) because Hirasawa was not patented or described in a printed publication in this country more than one year prior to the filing of the present application. Finally, Hirasawa does not qualify as prior art under 35 U.S.C. § 102(e) because Hirasawa was not described in a patent granted on an

application for patent by another filed in the United States before the invention by Applicant for patent.

Because Hirasawa does not qualify as prior art under 35 U.S.C. § 102(a), (b), and (c), it cannot be applied in the present rejection of claims 1-7, 10-13, 36-43, 46-51, 70, 72-77, and 80-84 were rejected under 35 U.S.C. § 103(a).

2. In the recent Office Action, claims 14-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap in view of U.S. Patent Application Publication No. 2002/0174433 to Baumgartner et al. (hereinafter “Baumgartner”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 14:

Claim 14 recites:

A display device connected to at least one recording device and at least one source of audiovisual programming, said display device comprising a user interface comprising:

a first window associated with a source of audiovisual programming;
and

a second window associated with a connected recording device;
wherein said first window displays an electronic program guide for said source of audiovisual programming, and said second window lists programs selected for future recording by a user from said electronic program guide, and

wherein said second window is further configured to display said audiovisual programming in response to a record command, such that both said first and second windows each display said audiovisual programming from said source of audiovisual programming associated with said first window to indicate that said recording device is recording said audiovisual programming associated with said first window.

(Emphasis added).

Support for the amendment to claim 1 can be found in Applicant’s originally filed specification at, for example, paragraphs [0034] and [0048].

In contrast, Yap and Baumgartner do not teach or suggest a display device connected to at least one recording device and at least one source of audiovisual programming comprising a user interface comprising a first and a second window wherein the second window is configured to display the audiovisual programming in response to a record command, such that both the first and second windows each display the audiovisual programming from the source of audiovisual programming associated with the first window to indicate that the recording device is recording the audiovisual programming associated with the first window.

The Office Action states that “Yap . . . discloses wherein said second window displays said audiovisual programming in response to a record command, such that both said first and second windows each display said audiovisual programming from said source of audiovisual programming associated with said first window to indicate that said recording device is recording said audiovisual programming associated with said first window (paragraph [0031]).” (Action, p. 10). However, Yap simply teaches the following:

Further enhancements to the present invention include *several modes*, including, but not limited to recording two or more signals where one or both may also be simultaneously viewed, recording one or more signals and playing back one or more signals, playing back two or more signals, watching one or more signals, while recording one or more other signals, viewing two or more live signals (through the use of picture-in-picture or other similar function), and viewing at least one signal live, while viewing one or more signals in playback mode.
(Yap, para. [0031])(emphasis added).

In other words, Yap simply teaches several modes of viewing recorded and live signals, and does not teach watching a single signal on two separate windows on a single display device. Further, Yap does not teach or suggest viewing a single signal on two separate windows on a single display device in order to confirm that the signal is being recorded on a recording device.

However, claim 14 recites a display device connected to at least one recording device and at least one source of audiovisual programming comprising a user interface comprising a first and a second widow wherein the second window is configured to display the audiovisual programming in response to a record command, *such that both the first and second windows each display the audiovisual programming from the source of audiovisual programming associated with the first window to indicate that the recording device is recording the audiovisual programming associated with the first window.* This subject matter is clearly outside the teachings of Yap and Baumgartner.

The Supreme Court recently addressed the issue of obviousness in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Yap and Baumgartner, did not include the claimed subject matter, particularly a display device connected to at least one recording device and at least one source of audiovisual programming comprising a user interface comprising a first and a second widow wherein the second window is configured to display the audiovisual programming in response to a record command, such that both the first and second windows each display the audiovisual programming from the source of audiovisual programming associated with the first window to indicate that the recording device is recording the audiovisual programming associated with the first window.

The differences between the cited prior art and the claimed subject matter are significant because the recitations of claim 14 provide for a means to confirm to a user that the audiovisual programming being currently view is, in fact, being recorded, and thus prevents the user from mistakenly failing to record the audiovisual programming. Thus, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 14 under 35 U.S.C. § 103 and Graham. Therefore, for at least the reasons explained here, the rejection based on Yap and Baumgartner of claim 14 and its dependent claims should be reconsidered and withdrawn.

3. In the recent Office Action, claims 18-31, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yap, in view of U.S. Patent No. 6,661,468 to Alten et al. (hereinafter “Alten”), and in further view of Hirasawa, and in still further view of Baumgartner. For at least the following reasons, this rejection should be reconsidered and withdrawn.

As argued above in connection with claims 1-7, 10-13, 36-43, 46-51, 70, 72-77, and 80-84, Hirasawa does not qualify as prior art under 35 U.S.C. § 102(a), (b), and (c). Therefore, Hirasawa cannot be applied in the present rejection of claims 18-31, 34, and 35 under 35 U.S.C. § 103(a).

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue, or comment in the Office Action does not signify agreement with or concession of that rejection, issue, or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

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